

# TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Application Number	10/609,012
Filing Date	June 27, 2003
First Named Inventor	Theo T. Nikiforov
Art Unit	1637
Examiner Name	Jeffrey Siew
Attorney Docket Number	100/07933

Total Number of Pages in This Submission

## ENCLOSURES (Check all that apply)

- |  |  |   |
|--|--|---|
| <input type="checkbox"/> Fee Transmittal Form<br><input type="checkbox"/> Fee Attached<br><input type="checkbox"/> Amendment/Reply<br><input type="checkbox"/> After Final<br><input type="checkbox"/> Affidavits/declaration(s)<br><input type="checkbox"/> Extension of Time Request<br><input type="checkbox"/> Express Abandonment Request<br><input checked="" type="checkbox"/> Information Disclosure Statement<br><input type="checkbox"/> Certified Copy of Priority Document(s)<br><input type="checkbox"/> Response to Missing Parts/Incomplete Application<br><input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53 | <input type="checkbox"/> Drawing(s)<br><input type="checkbox"/> Licensing-related Papers<br><input type="checkbox"/> Petition<br><input type="checkbox"/> Petition to Convert to a Provisional Application<br><input type="checkbox"/> Power of Attorney, Revocation<br><input type="checkbox"/> Change of Correspondence Address<br><input type="checkbox"/> Terminal Disclaimer<br><input type="checkbox"/> Request for Refund<br><input type="checkbox"/> CD, Number of CD(s) _____ | <input type="checkbox"/> After Allowance communication to Technology Center (TC)<br><input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences<br><input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)<br><input type="checkbox"/> Proprietary Information<br><input type="checkbox"/> Status Letter<br><input checked="" type="checkbox"/> Other Enclosure(s) (please identify below):<br>PTO Form 1449 (2 pages)<br>19 references |
|--|--|---|

### Remarks

Please charge Deposit Account No. 03-0177 for any additional fees associated with this paper or during pendency of this application

## SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	Andrew L. Filler, Reg. No. 44,107
Signature	<i>Andrew L. Filler</i>
Date	10-8-03

## CERTIFICATE OF TRANSMISSION/MAILING

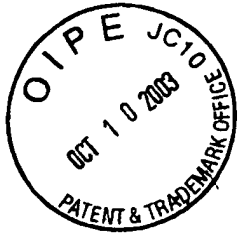
I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.

Typed or printed name	Michelle Chan
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Signature	<i>Michelle Chan</i>	Date	Oct 8, 2003
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This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Oct. 8, 2003

Signed: Michelle Chan  
Michelle Chan

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appln. No.	:	10/609,012	Confirmation No.:	8342
Applicant	:	Theo T. Nikiforov		
Filed	:	June 27, 2003		
TC/A.U.	:	1637		
Examiner	:	Jeffrey Siew		
Docket No.	:	100/07933		
Customer No.	:	021569		
Title	:	Assay Methods and Systems		

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT**

Sir:

The references cited on the attached form PTO-1449 are being called to the attention of the Examiner. A copy of each reference is enclosed.

With this Supplemental Information Disclosure Statement, Applicant would like to bring to the attention of the Examiner the existence of pending patent litigation involving U.S. Patent Nos. 6,287,774 and 6,472,141, which were granted on applicant's earlier related U.S. Patent Application Nos. 09/316,447 and 09/569,193 filed May 21, 1999 and May 11, 2000, respectively. Applicant is calling the existence of this litigation (Caliper Technologies Corp. ("Caliper") v. Molecular Devices Corporation ("MDC"), Civil Case No.: C-02-1837 (CRB) (N.D. California, April 17, 2002)) to the Examiner's attention in accordance with Section 2001.06(c) of the Manual of Patent Examining Procedure.

In connection with that litigation, on January 28, 2003, Caliper filed a Motion for Preliminary Injunction which asks the Court to enjoin further sales of MDC's infringing "IMAP" products. On April 1, 2003, MDC filed a response Opposition memorandum, denying infringement and arguing that the patents are invalid as anticipated, and unenforceable for inequitable conduct, due to Applicant's failure to disclose a publication by Seethala et al. entitled

"A Homogenous Fluorescence Polarization Assay for Src-Family Tyrosine Kinases," *Analytical Biochemistry*, **253**, 210-218 (1997), which reference has been previously submitted to the Examiner in related co-pending patent application Serial No. 10/397,887 and also is being submitted herewith. Caliper filed a Reply memorandum and supporting declarations on April 11, 2003. The Court held a claim construction hearing on June 30, 2003. The Court issued its Claim Construction Order in the pending litigation on September 3, 2003. Applicant is submitting herewith MDC's redacted version of its Opposition to Caliper's Motion for Preliminary Injunction in that pending litigation, as well as supporting declarations (redacted by MDC) from Professor Andrew R. Barron, MDC's noninfringement and invalidity expert, and Richard Sportsman, MDC's Vice-President of Assay and Reagent Research and Development, as well as a copy of the Court's 9/03/03 Claim Construction Order.

It is respectfully requested that the cited information be expressly considered during the prosecution of this application, and the references be made of record therein and appear among the "references cited" on any patent to issue therefrom.

As provided for by 37 CFR §1.97(g) and (h), no inference should be made that the information and references cited are prior art merely because they are in this statement and no representation is made that a search has been conducted or that this statement encompasses all possible relevant information.

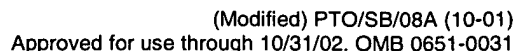
Applicants believe that no fee is required for submission of this statement, since it is being submitted within three months of the filing date or prior to the first Office Action. However, if a fee is required, the Commissioner is authorized to charge such fee to Deposit Account No. 03-0177. Please charge any additional fees or credit any overpayment to the above-noted deposit account.

Respectfully submitted,



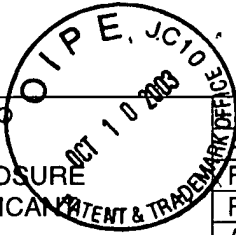
Andrew L. Filler  
Reg. No. 44,107

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Mountain View, CA 94043  
Tel: 650-623-0667  
Fax: 650-623-0504



Examiner Signature		Date Considered	
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\*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.



Substitute for form 1449A/PTO		Complete if Known		
INFORMATION DISCLOSURE STATEMENT BY APPLICANT  (use as many sheets as necessary)		Application Number	10/609,012	
		Filing Date	June 27, 2003	
		First Named Inventor	Theo T. Nikiforov	
		Art Unit	1637	
		Examiner Name	Jeffrey Siew	
Sheet		of	Attorney Docket Number	100/07933

AP	SEETHALA, R. et al., "A Fluorescence Polarization Competition Immunoassay for Tyrosine Kinases" <u>Anal. Biochem.</u> (1998) 255:257-262	
AQ	URIOS, P. et al., "Adaptation of Fluorescence Polarization Immunoassay to the Assay of Macromolecules" <u>Anal. Biochem.</u> (1990) 185:308-312	
AR	Molecular Devices Corporation's redacted version of its Opposition to Caliper's Motion for Preliminary Injection in pending litigation US Civil Case No. C-02-1837 (CRB) and supporting declaration by Andrew R. Barron and Richard Sportsman	
AS	Claim Construction Order, US District Court, Northern District of California, Case No. C 02-01837, September 3, 2003	

Examiner Signature		Date Considered	
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\*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.